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REMARKS

Claims 1 - 11 are pending in the present Application. No claims have been amended, leaving Claims 1 - 11 for consideration upon entry of the present Amendment.

Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1 - 11 stand rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over U. S. Patent No. 6,004,617 to Schultz et al. in view of U. S. Patent No. 5,200,230 to Poullos. (Office Action dated 08/09/2004, page 2; Office Action dated 12/23/2004, page 2) In making the rejection, the Examiner has stated that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a scanning mirror system having a mirrored surface positionable relative to an incoming radiation beam for delivering a laser beam to target regions on the substrate in Schultz et al since Poullos et al teach that a laser beam can be delivered to target regions on the substrate using a scanning mirror system having a mirrored surface positionable relative to an incoming radiation beam

(Office Action dated 08/09/2004, page 3). Applicants respectfully disagree.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

The present application is directed to a method for creating a combinatorial coating library, comprising selectively depositing at least one of a plurality of materials suitable for

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forming at least one coating layer on a surface of one or more substrates; selectively applying at least one of a plurality of curing environments to each of a plurality of regions associated with the at least one coating layer using a scanning mirror system having a mirrored surface positionable relative to an incoming radiation beam, wherein the mirrored surface is positionable to direct the incoming radiation beam to a selected one of the plurality of regions associated with the coating layer; and wherein the combinatorial coating library comprises a predetermined combination of at least one of the plurality of materials and at least one of the plurality of curing environments associated with each of the plurality of regions.

Schultz teaches methods and apparatus for the preparation and use of a substrate having an array of diverse materials in predefined regions thereon. (see Abstract) Schultz teaches that the properties can be measured using a variety of techniques. (Col. 29, line 36 – 49) As admitted by the Examiner, Schultz does not teach the use of a mirrored surface to direct incoming radiation. (Office Action dated 08/09/2004, page 3)

Poulios teaches a process and an apparatus for applying a fluorocarbon coating or film to a metal or other material surface of a substrate, and particularly for applying this coating to the hull of a ship, or to other objects to be submerged in fresh or saltwater. (see Abstract) As pointed out by the Examiner, Poulios teaches the use of scanner mirror. (see Figure 1)

In the first instance, Poulios even when combined with Schultz does teach all elements of the claimed invention. The mirrors disclosed by Poulios are not similar to those currently claimed. The scanner mirrors disclosed by Poulios are designed for positional adjustment of the beam during raster scanning of a selected region and not for redirecting the beam from one selected region to another. (Col. 5, lines 34 – 37) Thus, Poulios teaches scanner mirrors that permit positional adjustments of beam during raster scanning only after the position of the rastered area on the substrate is already selected. Further evidence of this can be seen in Col. 6, lines 21 – 35, where it is disclosed that the galvano-optical corrector 1 seen in Figures 1 and 2 maintains a constant beam spot size over a scanned target surface, by moving internal lenses closer and further away from each other. The X and Y galvo mirrors (2 and 3 respectively) are used for deflecting the beam spot along the X and Y-axis respectively only with respect to the galvano-optical corrector 1. (Col. 6, lines 21 – 35) The optical corrector 1 therefore focuses the beam based upon the adjustments made by the galvano-mirrors 2 and 3 only with

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respect to a selected rastered area. The galvano-mirrors 2 and 3 of Poullos cannot be used to reposition the beam onto a different region from that selected for raster scanning.

In contrast, the claimed mirrored surface of the present invention is positionable to direct the incoming radiation beam to a selected one of the plurality of regions associated with the coating layer. (see Claims 1 and 7) In other words, the mirror surfaces of the present invention permit deflection of the beam onto different regions of the coated layer, unlike those of Poullos, which permit deflection only within a selected region. Thus, Poullos, even when combined with Schultz does not teach all of the claimed elements. Establishing a *prima facie* case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

Further Poullos cannot be combined with Schultz to produce the claimed invention. Since the mirrors disclosed by Poullos are different from those presently claimed in their functionality, they cannot be used to direct incoming radiation onto a plurality of regions. Thus Poullos, even when combined with Schultz, would not produce the claimed invention.

Additionally, one of ordinary skill in the art would find no motivation to combine Schultz with Poullos. Schultz is directed at curing coatings on a substrate having multiple regions, where the reaction conditions at each region can be controlled independently. (Col. 10, lines 58 – 60) Schultz teaches that it is desirable for a single substrate to have at least 10 to 1,000,000 regions where various coatings can be synthesized.

Poullos on the other hand, discloses a method for manufacturing a coating that is applied to a single large surface such as that of a ship's hull, at any given time. (Col. 2, lines 15 – 25) Contrary to the Examiner's contention, one of ordinary skill in the art would not seek to combine a reference that is desirous of coating multiple regions with one that teaches coating a single large surface of a ship. Applicants contend that the Examiner has made this combination with hindsight provided by the present invention. The courts have held that "[f]urther, even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done." *Ex parte Levengood*, 28 U.S.P.Q. 1300 (Bd. Pat. App. Int. 1993).

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Additionally, there is no teaching either implicit or explicit in Schultz that discloses the advantages of using a mirror for purposes of directing radiation. Similarly, one of ordinary skill in the art upon reading Poullos would not find any teachings directed at a method for creating a combinatorial library. Thus, one of ordinary skill in the art upon reading Schultz and Poullos would not have found any teachings that would provide the motivation to combine them. It is therefore submitted that the Examiner has used impermissible hindsight in combining Schultz with Poullos, which is not the standard prescribed by the courts. In this regard, the courts have held that “[o]bviousness cannot be established by hindsight combination to produce the claimed invention.” *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). It is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination. *Id*

Further, while Poullos teaches the use of a mirror, it is submitted that one of ordinary skill in the art would have no motivation to combine Schultz with Poullos, since Poullos is from a field of non-analogous art. The current application is directed to a method for creating a combinatorial coating library. While Poullos deals with coatings, it is directed to manufacturing underwater coatings in sea-going vessels. One of ordinary skill in the art desirous of creating a combinatorial coating library would not search for a reference directed to underwater coatings on the hull of a ship, or to other objects to be submerged in fresh or saltwater, to protect their surfaces from corrosion, and/or from fouling by marine organisms.

In this regard the courts have stated “[f]or the purposes of evaluating obviousness of claimed subject matter, the particular references relied upon must constitute “analogous art”. *In re Clay*, 966 F.2d 656, 659, 23 U.S.P.Q.2d 1058, 1060-61 (Fed. Cir. 1992). The art must be from the same field of endeavor, or be reasonably pertinent to the particular problem with which the inventor is involved. *Id*.

In view of the fact that there is no motivation to combine references in the manner combined by the Examiner, Applicants respectfully request a withdrawal of the rejection under 35 U.S.C. § 103 over Schultz in view of Poullos and an allowance of the claims.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

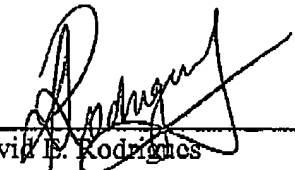
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If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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